

REMARKS

This response responsive to the non-final Office Action dated September 18, 2008. The Office Action rejected claims 18, 20, 24 and 25 under 35 U.S.C. §101. Claims 3, 4, 7-9, 11, 13, 18 and 20-25 were rejected under 35 U.S.C. §102(e) as being anticipated by Sin (U.S. Patent 7,227,583). Claims 10 and 12 stood rejected under 35 U.S.C. §103(a) as being unpatentable over Sin in view of Safadi et al. (U.S. Publication 2001/0051037). Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sin in view of Willame et al. (U.S. Publication 2006/0179462).

The Examiner is thanked for the courtesy for granting a telephone interview on August 18, 2009. During the telephone interview, proposed claim amendments were presented and differences between the claimed invention and prior art Sin were discussed. An agreement was reached that the rejection of claims 18, 20, 24 and 25 under 35 U.S.C. §101 would be overcome if the claims are amended as those presented herein. Furthermore, the Examiner agreed that the claim amendments as presented herein appear to overcome the anticipation rejection of claims 3, 4, 7-9, 11, 13, 18 and 20-25 based on Sin, but cautioned that the final determination of patentability is predicated on further search and/or review of prior art. The Examiner also suggested that the term “communication partner” in the claims might introduce potential concerns under 35 U.S.C. §101 as it may refer to a human being, and encouraged applicants to make appropriate changes.

By this Response, claims 3, 4, 7-12, 18 and 20-25 are amended. The amendments incorporate the proposed amendments presented during the interview and additional changes amending the term “communication partner” to “communication partner terminal,” per the Examiner’s suggestions. Dependent claims 26-31 are newly presented and specify that the incoming communication from the communication partner terminal is a request for voice

communications between the communication terminal and the communication partner terminal. No new matter has been introduced.

Claims 3, 4, 7-14, 18 and 20-31 are active for examination. Based on the agreements reached during the interview and for reasons discussed below, this application is in condition for allowance. Prompt favorable reconsideration of this application is respectfully requested.

Specific issues raised by the Office Action are addressed below.

The Rejections Under §101 Is Overcome

Method claims 18, 20, 24 and 25 were rejected under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. Specifically, the Office Action contended that the claims fail to tie to a particular machine.

By this Response, independent claims 18 and 20 are amended to specifically tie to a particular communication terminal. It is submitted that the rejection of claims 18 and 20 and their respective dependent claims 24 and 25 under 35 U.S.C. §101 is overcome.

The Rejection Under §102(e) Is Overcome

Claims 3, 4, 7-9, 11, 13, 18 and 20-25 were rejected under 35 U.S.C. §102(e) as being anticipated by Sin. As agreed upon during the telephone interview, claims 3, 4, 7-9, 11, 13, 18 and 20-25, after the claim amendments presented herein, overcome the anticipation rejection over Sin.

Sin is directed to very different techniques from the claimed invention. A system described in Sin provides a channel switch notice to a viewer who is watching a broadcast program so that the viewer knows when the broadcast program will end or will be switched to another channel. During this process, control unit 27 communicates with database 24 in order to obtain the end time information. The Office Action alleged that control unit 27 purportedly

corresponds to the claimed “communication terminal” and database 24 allegedly corresponds to the “communication partner.” However, even under such construction, control unit 27 and database 24 are included in the same housing. In contrast, claims 3, 4, 7-9, 11, 13, 18 and 20-25, after the amendments presented herein, all require that the claims features are directed to the communication between a communication terminal and a communication partner terminal “**external**” to the communication terminal. This feature is not available in Sin. Therefore, the anticipation rejection is overcome.

The Rejections Under §103(a) Are Overcome

Claims 10, 12 and 14 depend on claims 3 and 7, respectively, and were rejected under 35 U.S.C. §103(a) as being unpatentable over Sin in view of Safadi or Williame.

As discussed earlier relative to independent claims 3 and 7, Sin fails to meet every limitation of claims 3 and 7. Accordingly, Sin also fails to meet every limitation of claims 10, 12 and 14 by virtue of their respective dependencies from claims 3 and 7.

The two additional documents, Safadi and Williame, were cited by the Office Action for their purported discussions related to providing the end time using e-mail or acquiring a program end time included in a program table. These additional features, however, do not alleviate the deficiencies of Sin. Therefore, Sin, even if further modified by Safadi or Williame, still fails to meet every limitation of claims 10, 12 and 14. Accordingly, the obviousness rejections of claims 10, 12 and 14 are overcome.

New Claims 26-31 Are Patentable

New claims 26-31 depend on independent claims 3, 4, 7, 8, 18, 20, respectively, and further describe that the incoming communication from the communication partner terminal is a request for voice communications between the communication terminal and the communication

partner terminal. As described in the specification, the communication between the terminals is a telephone call. The combinations of the feature in claims 26-31 and limitations from their respective base claims describe unique devices and techniques to provide better user experience when using a user terminal.

The features described in the base claims as well as additional features described in claims 26-31 are unavailable from Sin. The communication between control unit 27 and database 24 in Sin is not a request for voice communications between control unit 27 and database 24. Therefore, Sin does not describe that the incoming communication from the communication partner terminal is a request for voice communications between the communication terminal and the communication partner terminal, as required by claims 26-31.

The two additional documents, Safadi and Williame, are directed to features relating to receivers for television signals (Willame) or set-top box with recording features (Safadi). Sin, even if modified by Safadi or Williame, still fails to provide features relating to voice communications and informing a caller about an end time of a video program being played on a communication terminal.

It is submitted that claims 26-31 are in condition for allowance. Favorable consideration of the claims is respectfully requested.

CONCLUSION

For the reasons given above, Applicants believe that this application is in condition for allowance, and requests that the Examiner give the application favorable reconsideration and permit it to issue as a patent. If the Examiner believes that the application can be put in even better condition for allowance, the Examiner is invited to contact Applicants' representative listed below.

Serial No.: 10/807,469

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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WDC99 1754251-3.062758.0075

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